

**Remarks**

This is a preliminary amendment in a continuation of application serial no. 09/628,980 filed February 11, 2000. As result of the preliminary amendment, original claims 1 and 3-6 and new claims 46 - 64 are pending in the application. Claims 2 and 7-45 have been canceled without prejudice or disclaimer.

In the parent application 09/628,980, in the Office Action mailed December 3, 2003, claims 1 and 4-6 were rejected under 35 USC 103(a) as being unpatentable over Farris et al. (U.S. Patent No. 6,574,216; hereinafter "Farris") in view of Li et al. (US Patent No. 5,617,423; hereinafter "Li").

Independent claim 1 relates to a method comprising the steps of determining whether a called party's audio device is able to support at least one voice compression algorithm supported by a calling party's audio device, and exchanging voice signals between the called party's audio device and the calling party's audio device via a data network, if the called party's audio device is able to support the at least one voice compression algorithm. The determining step is accomplished by exchanging messages between the called party's audio device and the calling party's audio device via a circuit switched network.

To establish a *prima facie* case of obviousness under § 103, all claim limitations of a claimed invention must be taught or suggested by the prior art. See MPEP, Section 2143.03 and *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In view of this authority, the Applicant respectfully submits that the cited references cannot support the asserted rejection.

The Office Action acknowledges that primary reference Farris does not disclose determining whether a called party's audio device is able to support at least one voice compression algorithm supported by a calling party's audio device, and exchanging voice signals between the called party's audio device and the calling party's audio device via a data network, if the called party's audio device is able to support the at least one voice compression algorithm as required by claim 1.

Secondary reference Li cannot remedy deficiencies in Farris with respect to establishing a *prima facie* case of obviousness for at least the reason that nothing in Li teaches or suggests a determining step accomplished by exchanging messages

between a called party's audio device and a calling party's audio device via a circuit-switched network, as required by claim 1.

Instead, Li relates to a fundamentally different arrangement, in which a personal computer system is configured with a number of hardware and software features purported to enable a variety of communication functions. However, none of the functions relates to a determining step accomplished by exchanging messages between a called party's audio device and a calling party's audio device via a circuit-switched network, as noted.

Accordingly, claim 1, and claims 3-6 dependent thereon, are allowable over the combination of Farris and Li.

Claims 2 and 3 were rejected in the Office Action in 09/628,980 as being unpatentable over Farris and Li, and further in view of Berry et al. (U.S. 5,758,256; hereinafter "Berry"). Claim 2 has been canceled.

Berry in combination with Farris and Li does not render claim 3 unpatentable for at the reason that claim 3 includes the limitations of claim 1. As discussed above, Farris and Li do not teach or suggest a determining step accomplished by exchanging messages between a called party's audio device and a calling party's audio device via a circuit-switched network, as required by claim 1. Berry does not remedy the deficiencies in Farris and Li. For example, contrary to the comments in the Office Action, FIG. 1 of Berry does not show the latter feature recited in claim 1. As stated in col. 3, lines 31-33 of Berry, the PSTN 26 shown in FIG. 1 is only present because "there will be calls originating from or destined for the PSTN 26 that the present method [disclosed in Berry] must account for." When a call is placed to or from a telephone on the PSTN 26, "[t]he switch 25 simply routes the calls between the different systems [i.e. the PSTN and a PCM system] and does not perform any special processing" (col. 3, lines 39-40). There is no teaching or suggestion in Berry of using the PSTN 26 to determine whether a called party's audio device is able to support at least one voice compression algorithm supported by a calling party's audio device, by exchanging messages between the called party's audio device and the calling party's audio device via the PSTN 26. Further, again contrary to comments in the Office Action, this feature is not taught or suggested by other parts

of the Berry specification or claim 1 of Berry. Therefore, claim 3 is allowable over Farris, Li and Berry.

Additionally, Farris, Li and Berry do not teach or suggest the features recited in new claims 46-64. Therefore, new claims 46-64 are allowable over the art of record.

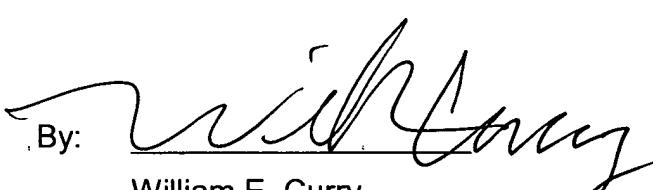
In light of the foregoing discussion, the Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

The Examiner is invited to contact the undersigned at (202) 220-4323 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

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